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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,738	03/04/2005	Jared S Timko	22188/06985	7877

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EXAMINER	
BASTIANELLI, JOHN	

ART UNIT	PAPER NUMBER
3753	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/526,738	TIMKO ET AL.	
	Examiner	Art Unit	
	John Bastianelli	3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *38-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *38-66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 October 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Suggestions

1. Claims 39 and 53 are objected to because of the following informalities: The packing is already cited as a single piece in claim 38. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The packing being a multi-piece packing contradicts the single piece packing of claim 38.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. The examiner would like to make the applicant aware that the claims are very close to double patenting with applicant's child case 11/247,353.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 64 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartmann US 3,214,135.

Hartmann discloses a valve having a valve body having a valve cavity therein (Fig. 1), a valve element 5 for controlling flow through the valve based on rotational position of the valve element about an axis, and a packing 15 and 16 that surrounds said valve element and seals said valve element within said valve cavity; wherein said valve element comprises a ball 5 and adjacent upper 7 and lower 6 trunnions; said lower trunnion 6 extending axially past a lower end of said packing, said valve cavity being dimensioned to closely receive said valve element while permitting said valve element to axially shift in two opposite directions to compensate for temperature effects on said packing (the valve cavity is big enough to compensate for

temperature effects so this is seen as inherent). The packing has load members by seals above and below the packing and/or 10 and 11.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 38-66, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Spock, Jr. et al. US 5,326,074 in view of Tow US 5,730,420.

Spock, Jr. discloses a valve 10 having a valve body 12 having a valve cavity 24 therein; a valve element 26 for controlling flow through the valve based on rotational position of the valve element about an axis, and a single piece packing 27 that surrounds said valve element and seals directly against said valve element within said valve cavity; wherein said valve element comprises adjacent upper and lower trunnions (area above and below the flow passage); said lower trunnion extending axially past a lower end of said packing (Fig. 2); said valve cavity being dimensioned to closely receive said valve element while permitting said valve element to axially shift to compensate for temperature effects on said packing. Spock, Jr. discloses a plug valve but lacks a ball as the valve element. Tow discloses a ball valve having a ratio of D3/D1 of .8 as measured by the drawings using the lower trunnion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the plug valve of Spock, Jr. ball shaped in the ratio as is shown by Tow in order to make the valve smaller as this

would cut the corners of the plug valve. The packing dimensioned by be installed within room temperature range is 65-100 degrees F is product by process as only the final outcome of an apparatus claim has patentable weight. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113). The packing has a ratio of H/D4 of about .8 as measured by the drawings. The packing is made of PTFE and over molded (product by process) and the valve element is non-spherical, and has an interference fit and this is seen as product by process. The valve cavity has a reduced diameter bore that receives the lower trunnions, the packing is live loaded. The packing may be seen as multi piece with piece 38.

10. Claims 38-60 and 62-66, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tow US 5,730,420 in view of Hartmann US 3,214,135.

Tow discloses a valve 10 having a valve body 12 having a valve cavity 20 therein; a valve element 40 for controlling flow through the valve based on rotational position of the valve element about an axis, and a single piece packing 50 that surrounds said valve element and seals directly against said valve element within said valve cavity; wherein said valve element comprises a ball 42 and adjacent upper and lower trunnions (above and below ball 42); said valve cavity being dimensioned to closely receive said valve element while permitting said valve element to axially shift to compensate for temperature effects on said packing. Tow lacks said lower trunnion extending axially past a lower end of said packing. Hartmann discloses said lower trunnion extending axially past a lower end of said packing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lower

trunnions of Tow extend axially past the lower trunnions as cited by Hartmann in order to insure that the lower trunnion does not slip out of the packing. The packing dimensioned by be installed within room temperature range is 65-100 degrees F is product by process as only the final outcome of an apparatus claim has patentable weight. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113). The packing has a ratio of H/D4 of about .8 and D3/D1 of about .8 as measured by the drawings. The packing is made of synthetic resin material such as PFA that is also seen as PTFE that is and over molded (product by process) and the valve element is non-spherical, and has an interference fit and this is seen as product by process. The valve cavity has a reduced diameter bore that receives the lower trunnions, the packing is live loaded. The packing may be seen as multi piece including the piece 94.

11. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tow US 5,730,420 in view of Hartmann US 3,214,135 as evidenced by Spock Jr. et al. 5,326,074. Tow discloses the packing is made out of a pliant plastic synthetic resin material but lacks a specific mention of PTFE. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the packing of Tow out of PTFE as evidenced by Spock, Jr as this is a pliant plastic synthetic resin material.

Response to Arguments

12. Applicant's arguments with respect to claims 38-66 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner would like to note that Abe discloses a single piece packing as well similar to Spock, Jr. Schmitt discloses a single piece packing that surrounds the valve element. Anderson and Perry disclose the equivalency of ball and plug valves.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Bastianelli whose telephone number is (571) 272-4921. The examiner can normally be reached on M-Th (8-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Bastianelli
Primary Examiner
Art Unit 3753

JB
November 21, 2006